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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/074,356	02/12/2002	Brian N. Tufte	1076.1101105	9075
28075	7590	09/08/2004	EXAMINER	
CROMPTON, SEAGER & TUFTE, LLC 1221 NICOLLET AVENUE SUITE 800 MINNEAPOLIS, MN 55403-2420				NEGRON, ISMAEL
		ART UNIT		PAPER NUMBER
				2875

DATE MAILED: 09/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/074,356	TUFTE, BRIAN N.	
	Examiner	Art Unit	
	Ismael Negron	2875	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 24 May 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-3,6-14,16-24 and 26-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 22 and 26-29 is/are allowed.
- 6) Claim(s) 1-3,6-14,16-21,23,24 and 30-50 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 02 January 2002 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>20031222</u> | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicant's amendment filed on July 3, 2004 has been entered. Claims 1, 10, 19, 21-24 and 26-28 have been amended. Claims 4 and 25 have been cancelled. Claims 30-50 have been added. Claims 1-3, 6-14, 16-24 and 26-50 are still pending in this application, with claims 1, 10, 19, 21-24 and 26-31 being independent.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-3, 6-14, 16-21, 23, 24 and 30-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over BURKITT, III et al. (U.S. Pat. 5,680,496) in view of BELL (U.S. Pat. 5,410,458).

BURKITT, III et al. discloses an elongated illumination device having:

- **an elongated member (as recited in claims 1, 10, 11, 19, 21, 23, 24, 30 and 31),** Figure 2, reference number 14;
- **an elongated light source (as recited in claims 1, 10, 11, 19, 21, 23, 24, 30 and 31),** Figure 2, reference number 12;

- **the elongated member having a cavity (as recited in claims 1, 10, 11, 19, 21, 23, 24, 30 and 31), Figure 2, reference number 28;**
- **the cavity being for receiving the elongated light source (as recited in claims 1, 10, 11, 19, 21, 23, 24, 30 and 31), column 3, lines 44-46;**
- **at least part of the cavity being defined by an at least semi-transparent material extending from the cavity to an outer surface of the elongated member (as recited in claims 1, 16, 20, 21, 23 and 24), column 3, lines 52-54;**
- **an elongated carrier (as recited in claims 1, 10, 11, 19, 21, 30 and 32) , Figure 2, reference number 16;**
- **the elongated carrier having a slot (as recited in claims 1, 10, 11, 19, 21, 30 and 32), as seen in Figure 2;**
- **the slot being for receiving the elongated member (as recited in claims 1, 10, 11, 19, 21, 30 and 32), as seen in Figure 2;**
- **the slot and the elongated member being adapted so that the elongated member must be at least partially elastically deformed or bent to insert the elongated member into the slot (as recited in claims 1, 10, 11, 12, 21 and 30), column 3, lines 60-66;**
- **at least part of the elongated member being at least partially elastically deformed or bent to insert the elongated light**

source through the slit into the cavity (as recited by claim 2),

column 3, lines 60-66; and

- the elongated light source being a linear emitting fiber (as recited in claims 8 and 18), column 3, lines 44-46.

BURKITT, III et al. discloses all the limitations of the claims, except:

- at least part of the cavity being defined by a non-transparent material extending from the cavity to an outer surface of the elongated member (as recited in claims 23 and 24);
- the elongated member having an elongated slit or opening (as recited in claims 1, 10, 11, 19, 21, 23, 24, 30 and 31);
- the elongated slit or opening extending from the cavity to an outer surface of the elongated member (as recited in claims 1, 10, 11, 19, 21, 23, 24, 30 and 31);
- the elongated carrier providing a closing force to the elongated slit or opening of the elongated member (as recited in claims 6, 10, 11 and 30);
- means for latching the slit into a closed or substantially closed position (as recited in claims 3 or 13)
- the elongated slit or opening being located in a non-viewing side of the elongated member (as recited in claim 31);

- the elongated slit or opening facing the elongated carrier when the elongated member is received by the elongated carrier (as recited in claims 19 and 32);
- the elongated slit or opening being an elongated slit (as recited in claim 33);
- the elongated slit or opening being an elongated opening (as recited in claim 34);
- the elongated light source being an electro luminescent wire (as recited in claims 7, 17 and 19);
- the slit being normally open so that the light source might be inserted (as recited in claims 9 and 14); and
- the elongated member being at least partially elastically deformed or bent to close the slit (as recited in claims 9 and 14).

BELL (U.S. Pat. 5,410,458) discloses illumination device having:

- **a light source (as recited in claims 1, 10, 11, 19, 21, 23, 24, 30 and 31)**, Figure 4, reference number 116;
- **an elongated member (as recited in claims 1, 10, 11, 19, 21, 23, 24, 30 and 31)**, Figure 4, reference number 104
- **the elongated member having a cavity (as recited in claims 1, 10, 11, 19, 21, 23, 24, 30 and 31)**, as seen in Figure 4;

- **the cavity being for receiving the light source (as recited in claims 1, 10, 11, 19, 21, 23, 24, 30 and 31), column 3, lines 30-33;**
- **at least part of the cavity being defined by an at least semi-transparent material extending from the cavity to an outer surface of the elongated member (as recited in claims 1, 16, 20, 21, 23 and 24), columns 2 and 3, lines 66-68 and 1-2, respectively;**
- **at least part of the cavity being defined by a non-transparent material extending from the cavity to an outer surface of the elongated member (as recited in claims 23 and 24), column 3, lines 64-68;**
- **the elongated member having an elongated slit or opening (as recited in claims 1, 10, 11, 19, 21, 23, 24, 30 and 31), Figure 4, reference number 110;**
- **the elongated slit or opening extending from the cavity to an outer surface of the elongated member (as recited in claims 1, 10, 11, 19, 21, 23, 24, 30 and 31), as seen in Figure 4;**
- **the elongated slit or opening being located in a non-viewing side of the elongated member (as recited in claim 31), as seen in Figure 4;**
- **the elongated slit of opening being an elongated slit (as recited in claim 33), as seen in Figure 4;**

- **the elongated slit or opening being an elongated opening (as recited in claim 34), as seen in Figure 4;**
- **the elongated light source being an electro luminescent wire (as recited in claims 7, 17 and 19), as suggested in column 3, lines 56-60;**
- **the slit being normally open so that the light source might be inserted (as recited in claims 9 and 14), as seen in Figure 4; and**
- **the elongated member being at least partially elastically deformed or bent to close the slit (as recited in claims 9 and 14), as suggested by Figure 4.**

It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to include the slit of BELL in the elongated member of BURKITT, III et al. to be able to easily remove the light source in the event that it needs service or replacement, as per the teachings of BELL (see column 3, lines 51-55). It would have further been obvious to place such slit on the side facing the elongated carrier (as recited in claims 19 and 32) for presenting a continuous and uniform output surface and for preventing the light source from being accidentally removed from the elongated member. Such arrangement would inherently force the elongated carrier to provide a latching function with closing force to the slit (as recited in claims 3, 6, 10, 11, 13 and 30).

The examiner takes Official Notice that the use of ELEs is old and well known in the illumination art. Even if BELL lacked suggestion to use an electro luminescent (ELE) light string (which it does not), it would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute a ELEs for the incandescent light string in the system of BELL. One would have been motivated since ELEs are recognized in the illumination art to have many desirable advantages, including reduced size, high efficiency, low power consumption, long life, resistance to vibrations, and low heat production, over other light sources.

3. Claims 35-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over BURKITT, III et al. (U.S. Pat. 5,680,496) in view of BELL (U.S. Pat. 5,410,458).

The teachings of BURKITT, III et al. and BELL disclose individually, or suggest in combination, all the limitations of the claims (as detailed in Section 2 of the instant Office Action), except the elongated carrier being adapted to be secured to a stair step.

The applicant is advised that it has been held by the courts that the recitation that an element is "adapted to" perform a function or serve in a given application is not a positive limitation, but only requires the ability to so perform. *In re Hutchinson*, 69 USPQ 138. In this case, it would have been obvious to one of ordinary skill in the art at the time the invention was made that the patented invention of BURKITT, III et al. is capable of being secured to a stair step. Figures 1 and 2 of BURKITT, III et al., where the elongated carrier 16 is shown fastened by screws 20 and adhesive 26 to surface 18, evidence such capability.

4. Claims 39-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over BURKITT, III et al. (U.S. Pat. 5,680,496) in view of BELL (U.S. Pat. 5,410,458).

The teachings of BURKITT, III et al. and BELL disclose individually, or suggest in combination, all the limitations of the claims (as detailed in Section 2 of the instant Office Action), except the elongated carrier being adapted to provide a bumper function for a boat, wall or shelving.

The applicant is advised that it has been held by the courts that the recitation that an element is "adapted to" perform a function or serve in a given application is not a positive limitation, but only requires the ability to so perform. *In re Hutchinson*, 69 USPQ 138. In this case, it would have been obvious to one of ordinary skill in the art at the time the invention was made that the apparatus formed by the combined teachings of BURKITT, III et al. and BERLL is capable of providing such bumper function. Such capability is evidenced in column 3 (lines 49-51) of BELL, where the elongated member 104 is recited as providing the light source 116 with protection from impact. In addition, Figure 2 of BURKITT, III et al. shows the elongated member 14 as featuring a cavity 28 capable of providing a cushion for a bumper function.

Relevant Prior Art

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Tieszen (U.S. Pat. 4,376,966) and **McName** (U.S. Pat. 5,180,223) disclose illumination devices having linear light sources received by elongated member formed at least in part by a transparent material. An elongated carrier in turn receives the elongated member.

Guth (U.S. Pat. 2,277,433), **Groningen** (U.S. Pat. 3,551,723), **Johnson** (U.S. Pat. 4,418,378) and **Emmel et al.** (U.S. Pat. 6,511,204) disclose elongated members having a cavity for receiving an elongated light source, such members having a slit or opening located in a non-viewing side of the elongated member.

Allowable Subject Matter

6. Claims 22 and 26-29 are allowed.
7. The following is a statement of reasons for the indication of allowable subject matter:

Applicant teaches an illumination device having an elongated light source received in a cavity of an elongated member, such member being received in a slot of an elongated carrier. The elongated light source is inserted in the cavity through a slit formed in the elongated member. The slot and the member are adapted so that when the elongated member is in the slot, the carrier provides a closing force to keep the slit

in the elongated member closed, or substantially closed. The carrier is at least partially deformed to receive the elongated member.

No prior art was found teaching individually, or suggesting in combination, all of the features of the applicants' invention, specifically the carrier being deformed to receive the elongated member.

Response to Arguments

8. Applicant's arguments with respect to claim1-3, 6-14, 16-24 and 26-50 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ismael Negron whose telephone number is (571) 272-2376. The examiner can normally be reached on Monday-Friday from 9:00 A.M. to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra L. O'Shea, can be reached on (571) 272-2378. The facsimile machine number for the Art Group is (703) 872-9306.

10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications maybe obtained from either Private PAIR or Public PAIR. Status

information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, go to <http://pair-direct.uspto.gov>. Should you have questions on access to Private PAIR system, contact the Electronic Business Center (EBC) toll-free at 866-217-9197.



August 28, 2004



**JOHN ANTHONY WARD
PRIMARY EXAMINER**